Remarks

A reconsideration of the present application is respectfully requested. Claims 16 and 23 have been amended to perfect the Examiner's contended indefiniteness. Claims 30 and 31 have been added. Claims 1-31 remain in the application for consideration by the Examiner.

Claims 16 and 23 stand rejected under 35 U.S.C. §112 as being indefinite. Claims 16 and 23 have been amended to incorporate the limitations of the independent claims from which they depend and are now presented in a condition for allowance.

Claims 1, 3, 4, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Broomhall, et al. Applicant's respectfully traverse this rejection.

In order to rely on a reference under 35 U.S.C §103(a), it must be analogous prior art. MPEP §2141.01(a). The test for obviousness is whether the combined teachings of the prior are, taken as a whole suggest the modifications to the person of ordinary skill in the art. *In re Napier*, 55 F.3d 310, 34 USPQ2d 1782 (Fed. Cir. 1995). See also *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). "Obviousness cannot be established by combining the teachings of the prior are to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986).

Neither Swift, et al. nor Broomhall, et al. are analogous prior art. Swift, et al. is directed to a method and apparatus for merging user accounts from one security domain to another and in the process modifying account identifications that are identical between the domains. The modification in Swift, et al. is achieved by appending an underscore '_' and a number to the original account identification.

Broomhall, et al. is directed to a system and method for generating user accounts on a network server for legitimate employees and contractors. Broomhall, et al. presents a profile to a user, which describes and identifies information about the new account user. Broomhall, et al. does not present a choice of generated user account names from which a user may then make a selection.

Swift, et al. modifies existing account names by appending an underscore and the next available numeric sequence. Swift, et al. does not provide for any alternative forms of account name generation, such as prepended adjectives, appended nouns, or the generation of a uniquely descriptive account name through the combination of adjectives and nouns from a selection pool within a database as in applicant's invention. Even further, applicant's invention provides intelligence to the unique account name generation process, by utilizing a variety of word element combinations and limiting the number of name generation attempts within each element combination variety. Further still, applicant's invention provides the user with a list of generated account names rather than just a profile display relating to an existing account name as taught in Broomhall, et al.

Examiner has the initial burden of showing an incentive to combine multiple references to support an obviousness determination:

> 'When the incentive to combine the teachings of the reference is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper'

Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1790 (BPAI 1987). Furthermore, some suggestion to combine the references is necessary.

> "If the invention is different from what is disclosed in one reference, but the differences are such that combination with another reference would lead to what is clamed, the obviousness question then requires inquiry into whether there is reason, suggestion, or motivation to make that combination."

Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996). Here, the incentive to combine the teachings of the reference is not readily apparent.

There is nothing that teaches, suggests or motivates the combination of the simplified sequential name generation of Swift, et al. with the verification and visual display of a user's profile in Broomhall, et al. to arrive at the sophisticated account name generation process of applicant's invention. Applicant's invention employs a unique variable and modifiable method for generating account names. In fact, by utilizing the database of nouns and adjectives, applicant's invention allows a naming format to be modifiable by an account hosting end user. For example, between company A and B the list of supplied adjectives and nouns could be quite different, thus resulting in generated account names that are completely dissimilar from which users may then make a selection. On the other hand Swift et al. can only produce similar user identifications and

there is no means for end user selection. A profile display as taught in Broomhall, et al. is in no way related to or suggestive of presenting a user with a choice of unique account names.

Examiner incorrectly states that Broomhall, et al. discloses an adjective and affix word element. Applicant's are unable to locate any such reference in Broomhall, et al. as to the use of an affix or adjective.

Claims 2, 5, 11, 13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Broomhall, et al. as applied to claim 1 and further in view of Polnerow, et al. Polnerow, et al. is directed to an on-line directory service and the monitoring thereof. Polnerow, et al. generates names by a random selection and combination of names from a list of first names and last names to provide a basis for a query to monitor the status of the on-line directory service. Polnerow, et al. does not teach nor suggest the use of such names to create user log on identification or account names. There is also no suggestion to combine the teachings of Polnerow, et al. with those of Swift, et al. or Broomhall, et al. As previously discussed, Swift, et al. and Broomhall, et al. are not combinable. Even further, there is nothing to suggest or teach combining the teachings of Polnerow, et al. or the teachings of Swift, et al. and Broomhall, et al.

Claims 6, 7 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Broomhall, et al. as applied to claim 1 and further in view of Ramasubramani, et al. As discussed above, applicant's invention is neither obvious nor suggested by the teachings of Swift, et al. or Broomhall, et al. when

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considered alone or in combination. For this reason, the invention cannot be obvious in light of Swift, et al. or Broomhall, et al. in view of any additional references.

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Ramasubramani, et al. as applied to claim 6 above, and further in view of Polnerow, et al. As discussed above, applicant's invention is neither obvious nor suggested by the teachings of Swift, et al. or Ramasubramani, et al. when considered alone or in combination. For this reason, the invention cannot be obvious in light of Swift, et al. or Ramasubramani, et al. in view of any additional references.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Polnerow, et al. as applied to claim 6 above, and in further view of Ramasubramani, et al. As discussed above, applicant's invention is neither obvious nor suggested by the teachings of Swift, et al. or Polnerow, et al. when considered alone or in combination. For this reason, the invention cannot be obvious in light of Swift, et al. or Polnerow, et al. in view of any additional references.

Claims 17-18 and 20-22 stand rejected under 35 U.S.C. §103(s) as being unpatentable over Swift, et al., Broomhall, et al. and Polnerow, et al. As previously discussed with respect to each of the cited references there is nothing to suggest combining these references as contended by the Examiner.

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Polnerow, et al. as applied to claim 17 above, and further in view of Broomhall, et al. As discussed above, applicant's invention is neither obvious nor

suggested by the teachings of Swift, et al. or Polnerow, et al. when considered alone or in combination. For this reason, the invention cannot be obvious in light of Swift, et al. or Polnerow, et al. in view of any additional references.

Claims 24, 25 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Broomhall, et al. As discussed above, applicant's invention is neither obvious nor suggested by the teachings of Swift, et al. or Broomhall, et al. when considered alone or in combination. For this reason, the invention cannot be obvious in light of Swift, et al. or Broomhall, et al. in view of any additional references.

Claims 27 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Broomhall, et al. as applied to claim 24 in further view of Polnerow, et al. As discussed above, applicant's invention is neither obvious nor suggested by the teachings of Swift, et al. or Broomhall, et al. when considered alone or in combination. For this reason, the invention cannot be obvious in light of Swift, et al. or Broomhall, et al. in view of any additional references.

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swift, et al. and Broomhall, et al. as applied to claim 24 in further view of Ramasubramani, et al. As discussed above, applicant's invention is neither obvious nor suggested by the teachings of Swift, et al. or Broomhall, et al. when considered alone or in combination. For this reason, the invention cannot be obvious in light of Swift, et al. or Broomhall, et al. in view of any additional references.

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In light of the foregoing applicant's respectively request that the Examiner withdraw the rejections and allow claims 1-15, 17-22 and 24-29 as filed. Applicant's further request that the Examiner allow claims 16 and 23 as amended and further allow claims 30 and 31 as added.

Conclusion

Claims 30 and 31 have been added. No new matter has been added and there is sufficient disclosure within the present application to support the added and amended claims. Claims 1-31 are now believed to be in condition for allowance based on the above amendments and remarks. Allowance of all claims is hereby requested. However, if the Examiner believes that any issues remain, please feel free to contact the undersigned at the telephone number below. Notice of allowance of claims 1-31 is earnestly solicited.

Respectfully submitted,

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Version With Markings to Show Changes Made

16. A computer-readable medium having computer-executable instructions for [performing the steps recited in claim 1] a method of producing a unique modified account name based on a requested account name that has been determined to already exist, the method comprising the steps of:

selecting a word element from a list of word elements;

combining the word element and the requested account name to produce a modified account name;

comparing the modified account name with a list of existing account names to determine whether the modified account name is unique; and

if the modified account name is unique, providing the modified account name to the user for acceptance.

23. A computer-readable medium having computer-executable instructions for performing [the steps recited in claim 17] a method of producing a unique random account name in response to a request by a user, the method comprising the steps of:

selecting a first word element from a database including a list of word elements;

selecting a second word element from the database;

combining the first and second word elements to produce a random account name;

comparing the account name with a list of existing account names to determine if the account name is unique; and

if the account name is unique, providing the account name to the user for acceptance.